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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,297	04/25/2001	Jose A. Sobrado	020431.0772	7102

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EXAMINER


MAMMEN, NATHAN SCOTT

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/842,297	<b>Applicant(s)</b> SOBRADO ET AL. 	
	<b>Examiner</b> Nathan S Mammen	<b>Art Unit</b> 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15,17-21,23-32,34-38,40-49 and 51-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,17-21,23-32,34-38,40-49 and 51-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 7, 9, 10, 17, 18-21, 23-24, 26-27, 32, 34, 35-38, 40-41, 43-44, 49, 51, 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,415,270 to Rackson et al.

The Rackson '270 patent discloses a system and method for providing guided buying decision support within an electronic marketplace. The system and method comprise a server (30) operable to interact with buyers to receive procurement parameters (col. 24, lines 6-8). The system and method further comprise an option generator operable to receive the parameters for a particular item needed by a buyer (col. 24, lines 6-8). The option generator determines one or more acceptable item-supplier combinations (col. 25, lines 3-19), generates one or recommended options for communication to the buyer (col. 25, lines 17-55). The recommended option includes a recommended auction in which the item is being auctioned. The "auction" includes both regular auctions and reverse auctions (col. 1, lines 27-36, and col. 3, lines 33-40). The server communicates with the buyer a recommended course of action (col. 25, lines 30-34, and col. 25, lines 61-64). The server interacts with the buyer and automatically initiates the service specified in the recommended option in order to procure the item (col. 25, lines 35-55).

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Regarding claims 2-4, 6, 7, 9, 10, 17, 19-21, 23-24, 26-27, 32, 34, 36-38, 40-41, 43-44, 49, 51 : The procurement parameters include characteristics of the item (col. 24, lines 6-8), a date by which the item must be procured (col. 24, lines 11-13), and an acceptable supplier of the item (col. 24, lines 22-26). The server and buyer communicate through displays (400 and 500). When the buyer inputs a procurement parameter, the display (400) allows the buyer to see in substantially real time the impact of the procurement parameter (col. 24, lines 41-44). One of the recommended options includes a recommended purchase (col. 25, lines 39-41) determined by a bid exchange (col. 24, lines 35-39). The recommended option is a recommended auction that includes circumstances of the date the auction is scheduled to be completed or the probability of winning the auction (col. 26, lines 10-14 and 18-20). The manager is operable to recommend a bid for placement in a recommended auction (col. 25, lines 61-64). The system and method are carried out as an electronic marketplace.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 11-15, 25, 28-31, 42, 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,415,270 to Rackson et al.

The Rackson '270 patent discloses the claimed invention, as stated in paragraph 2 above, except for the factors used to determine the probability of winning an auction. However, in view of the teachings of the Rackson '270 patent concerning determining the probability of winning

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an auction, considering the factors of length of time the auction has been running or will continue to run and the percentage of possible buyers that could participate would have been obvious to one having ordinary skill in the art. See col. 24, lines 51-56.

Regarding claim 11, 28, 45-48: When a system engages in proxy bidding (col. 25, lines 61-64) for a buyer in an auction, it is well-known to conduct the proxy-bidding by specified increments.

Regarding claims 12-15, 29-31: The Rackson '270 patent clearly discloses that the recommended option can be a reverse auction (col. 1, lines 27-36, and col. 3, lines 33-40). The Rackson '270 patent also discloses determining the probability of success in auctions (col. 24, lines 51-56). While the Rackson '270 patent does not disclose the specific claimed factors, such as the length-of-time of the reverse auction or the number of suppliers capable of satisfying the procurement parameters, in view of the overall teachings of the Rackson '270 patent determining the probability of success based on those factors would have been obvious.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-4, 6-15, 17-21, 23-32, 34-38, 40-49, 51-55 have been considered but are moot in view of the new ground(s) of rejection.

In particular, the Rackson '270 patent discloses the combination of limitations added to the independent claims, such as recommended options and communication between the buyer and the server concerning the recommended option.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,636,836 to Pyo discloses a system for making recommendations to

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a user (col. 4, lines 26-44). U.S. Patent No. 6,633,852 to Heckerman et al. discloses a uses buyer inputs to make product recommendations (col. 4, lines 32-51). U.S. Patent No. 5,715,402 to Popolo discloses a system for matching buyers and sellers based on procurement parameters (col. 1, line 46 - col. 2, line 12). U.S. Patent No. 4,992,940 to Dworkin discloses a system for finding a product and seller matching a buyers specifications (col. 2, lines 6-25).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

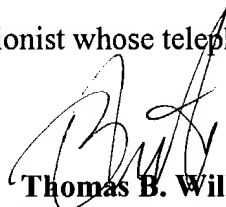
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.



**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**

**NSM**  
**5/14/04**

**Nathan S. Mammen**